

IN THE  
United States Circuit Court of Appeals  
FOR THE NINTH CIRCUIT

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RUDOLPH LENSCHE AND PAUL LEDER,

*Appellants.*

*vs.*

METALLIZING COMPANY OF AMERICA, a corporation, L. E.  
KUNKLER, CHARLES BOYDEN and JOSEPH GOSSNER,

*Appellees.*

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APPELLEES' BRIEF.

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WILLIAM R. LITZENBERG,  
448 South Hill Street, Los Angeles,  
*Attorney for Appellees.*

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## TOPICAL INDEX.

	PAGE
The Jurisdiction.....	1
The Trial—A Statement .....	1
The Patent in Suit—Summary.....	2
The Alleged Infringing Device—Summary.....	4
In re Appellants' Opening Brief.....	4
Some General Principles Involved Herein.....	6
The First Inventive Act in Metal Spraying.....	7
The Application for the Patent in Suit.....	8
The Specification .....	8
The Original Claims Rejected.....	9
Original Claims Cancelled and New Limited Claims Presented	10
The New Claims and Their Limitations.....	12
Testimony of Expert Witness Stokes.....	20
Defense of Prior Public Use and Offer for Sale.....	23
Summary of Evidence Supporting Prior Public Use and Sale.....	26
“The Metallizer”—Defendants’ Magazine.....	36
The Law Applicable Herein:	
Mechanical Skill v. Invention.....	37
Secondary Patents .....	40
Self-Imposed Limitations in Claims.....	41
Prior Public Use and Offer for Sale.....	43
Conclusions .....	47

TABLE OF AUTHORITIES CITED.

CASES.	PAGE
American Stainless Steel Co. v. Rustless Iron Corp., 71 Fed. (2d) 404, 407.....	46
Atlantic Works v. Brady, 107 U. S. 200, 27 L. Ed. 438.....	38, 40
Belding v. Challenge, 152 U. S. 100, 38 L. Ed. 370.....	40
Busel v. Stevens, 137 U. S. 423.....	40
Capital Sheet-Metal Co. v. Kinnear & Gager Co., 87 Fed. 333, 336 .....	38
Chicago & N. W. Ry. Co. v. Sayles, 97 U. S. 554, 557, 24 L. Ed. 1053-4 .....	40
Consolidated v. Bernard, 156 U. S. 261, 39 L. Ed. 417.....	41
Consolidated v. Walker, 138 U. S. 124, 34 L. Ed. 920.....	39
Duff v. Sterling, 107 U. S. 636, 27 L. Ed. 517.....	16, 40
Electric Storage Battery Co. v. Shimadzu, 307 U. S. 19.....	46
Globe Oil Refining Co. v. Sinclair Refining Co., 103 Fed. (2d) 95, 97 .....	46
Herman Body Co. v. St. Louis Body Co. (8th Cir.), 46 Fed. (2d) 879 .....	26
Hollister v. Benedict Mfg. Co., 113 U. S. 59, 28 L. Ed. 301....	38, 40
Ideal v. Crown, 131 Fed. 244, 65 C. C. A. 436.....	20
James v. Campbell, 104 U. S. 356, 382, 26 L. Ed. 786.....	44
Matheson v. Campbell, 69 Fed. 597, 607; cases cited.....	42
McClain v. Ortmayer, 141 U. S. 418, 35 L. Ed. 800.....	7
Maibohn v. RCA-Victor Co., 89 Fed. (2d) 317, 321.....	46
Miller v. National Broadcasting Co. (3d Cir.), 79 Fed. (2d) 657 .....	46
Morgan v. Albany, 152 U. S. 425, 38 L. Ed. 500.....	42
National Biscuit v. Crown Baking Co., 105 Fed. (2d) 422, 425..	45
National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co., 106 Fed. Rep. 693, 714, 45 C. C. A. 544.....	11
Newton v. Furst, 119 U. S. 373, 30 L. Ed. 442, 7 S. Ct. 369..	40

	PAGE
New York Belting & Packing Co. v. Magowan, 27 Fed. Rep. 362, 364 .....	38
Oliver-Sherwood Co. v. Patterson-Ballagh Corp., 95 Fed. (2d) 70 (9th Cir.).....	25
Penn. v. Locomotive, 110 U. S. 490, 20 L. Ed. 222.....	39
Shepard v. Carrigan, 116 U. S. 593.....	42
Smith v. Nichols, 88 U. S. 112.....	39
Stephenson v. Brooklyn, 114 U. S. 149, 29 L. Ed. 58.....	39
Thompson v. Boisselier, 114 U. S. 1, 29 L. Ed. 76.....	38, 40
Wagner v. Meccano, Ltd., 246 Fed. 603, 607.....	44
Wende v. Horine, 225 Fed. 501, 504.....	43
Western v. Robertson, 142 Fed. 471, 478, 73 C. C. A. 587.....	41
Williams Mfg. Co. v. Franklin, 41 Fed. Rep. 393, 395.....	38
Winans v. Denmead, 14 How. 330, 14 L. Ed. 717.....	40
Woodbridge v. United States, 263 U. S. 50, 56.....	43

#### TEXTBOOKS.

Macomber's "The Fixed Law of Patents" Text.....	6
Walker on Patents, Fourth Edition, Sec. 359.....	41



No. 10,000

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## APPELLEES' BRIEF.

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### **Jurisdiction.**

The jurisdiction, in all respects, is conceded by appellees.

### **The Trial.**

The Court to whom this case was assigned for study and decision after the trial, and after the sudden death of the Hon. William P. James, who heard the case, was at a great disadvantage. However, without the advantage of seeing and hearing the witnesses, and without the advantage of hearing the mechanical exhibits orally analyzed and explained in their disclosures and relationships, and particularly, an oral comparison between the model of the invention in the patent sued on and the alleged infringing device; nevertheless, the Court has shown a very clear understanding of the alleged invention, and the alleged infringing device, in connection with the patents and the mechanisms of the prior art (included in the opinion), and the law pertaining to the matters involved herein.

### The Patent in Suit—Summary.

The patent sued on [Exhibit No. 1], No. 2,096,119, issued October 19, 1937, on an application filed April 13, 1936, includes early in its specification, as its first object:

"the provision of certain new and novel features and advantages beyond the improvements in metal spraying devices as set out in United States Letters Patent granted to Rudolph Lensch and Paul Leder, January 8, 1935, No. 1,987,016."

Plaintiff's gun, made under the patent in suit, is Exhibit No. 5.

Defendants contend that said so-called "new and novel features and advantages," by plaintiffs, at most, were only mechanical skill improvements over their prior patent referred to [Exhibit "K"]: and furthermore, that these so-called improvements were all found to be old in the prior art discovered by defendants, and not cited by the Patent office against the application on which said patent in suit was issued.

Only two patents were cited by the Patent Office in rejecting all of the original claims except one. [File Wrapper, Exhibit A. R. 405.]

Defendants cited some eight prior patents, foreign and domestic, not found by the Patent Office, and which clearly show that all the structural features of the patent sued on, were old, very old, in the same art. These prior patents are dealt with more in detail later herein. They are also referred to in the opinion of the Trial Court. [R. 25-35.] As examples:

The idea of "controlling the wire feed through the gun whereby any desired pressure may be exerted on the wire," is taught in the Valentine patent, Exhibit G [R. 464], not

considered by the Patent Examiner; and by the Irons patent, Exhibit H [R. 472]; and by the French patent, Exhibit C [R. 442], not considered by the Patent Office.

The idea of providing "a hinged latch construction whereby the top feeding wheel is releasably confined," and whereby it "can be unlatched and lifted on its hinged connection out of the way," was old in plaintiffs' prior patent, Exhibit K [R. 488]; also in said old French patent, Exhibit C.

The idea of forming "the combustion unit of a gun as a separate and distinct entity from the mechanical unit or power plant of the gun" was also old in the French patent, Exhibit C [R. 442]; in the metallizing gun, Exhibit No. 6; and in the Valentine patent, Exhibit G [R. 464].

The idea of providing in a spray gun "a casting as an integral part which will contain the housings (plural) for encompassing the gears of the transmission as well as the turbine for driving the transmission gears and to so form the casting that it will have a channel way for the feed wire, free and clear of the interiors of the gear and turbine housings," was also old many years prior to the application. This is most clearly shown in the old French patent, Exhibit C [R. 442]: and in the French gun, Exhibit N; and in the different publications, such as "El Salvador" Defendants' Exhibit O, which seems to have been omitted from the Book of Exhibits.

In other words, all of the general objects set forth in the patent specification were already known in the prior art, and particularly in the French patent, the Valentine patent, the Irons patent and the British patent No. 268,431, Exhibit F.

### The Alleged Infringing Device—A Summary.

The alleged infringing device is known as the "MOGUL" gun and is Exhibit No. 8. It had been designed, built and was on the market in February of 1936 [R. 78, 159]. No application for patent was ever filed therefor [R. 172]. The inventor did not consider it patentable, for in addition to making mechanical improvements on their prior gun, the "Metallizer," Exhibit No. 6 [R. 160-162], Mr. Boyden said he got some ideas for improvements thereof from certain foreign patents for Spray Guns, and from circulars thereof, received from a Mr. Gossner, their exporter [R. 162], who had his agents in Germany, France and Switzerland, and particularly from a certain old French patent No. 680,554, of December, 1928, Exhibit C, and from an old French gun, Exhibit N, **which was a trade-in on one of their "Metallizers."** Said French gun is shown in said French patent.

The "MOGUL" gun was really a refined copy of the French gun, and improvements made in their "Metallizer" gun, Exhibit No. 6, and did not involve invention for this reason.

### In Re Appellants' Opening Brief:

In their "Brief History of the Metal Spraying Art," it is stated that "Contemporaneous with plaintiffs' invention, the art began to assume great commercial importance and continues to grow in popularity."

The art was well developed long before plaintiffs ever entered the field. The prior art clearly proves this.

When plaintiffs, on page 5, state that "The prior art is completely devoid of such features: 'the location of

knurled wheels which deliver the wire, in an open channel between the wall of the turbine housing and the adjacent wall of the transmission housing; " they are pointing out the only different feature they have from the prior art and the reason for the limitation in all of their claims. Defendants contend that even this is nothing more than ordinary mechanical skill.

Plaintiffs' opening brief is given largely to trying to make out that old and well known elements, constructions and arrangements, were new and original with them, overlooking the many prior patents **not considered by the Patent Office** in considering and rejecting their application.

Plaintiffs' photostatic illustration of defendants' Mogul gun, between pages 24 and 25, in the lower illustration shows the hinged member carrying the upper feed wheel thrown back, in an attempt to try to make out that defendants' gun has an "open channel." This can be opened for inspection, but must be closed for operation and when closed, said feed wheels and wire cannot be seen, as can they in plaintiff's spray gun.

It is only necessary to read Mr. Boyden's testimony to see that here was an honest engineer and mechanic trying to make it clear that he did not consider that **any of these guns involved anything more than mechanical skill**, including his own, and that they all operated in substantially the same manner [R. 212]; and plaintiffs would seem to indicate that one manufacturer has not the right to study his competitors' products and even his patents and try to improve upon them. That is provided for in our patent laws—patents for improvements, if those improvements rise to the dignity of invention.

## Some General Principles Involved Herein:

That much of what use to be considered invention is today considered to be the result of mechanical skill only, by reason of the high degree of development in the field of engineering knowledge and mechanical skill. Or, as it has been stated in another way:

**“The education of today makes mechanical skill of what might have been inventive genius fifty years ago.”** (Macomber: “The Fixed Law of Patents,” page 48.)

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In the construction of patents and patent claims, it must be born in mind that the general public and industry have acquired rights in the fields of invention and mechanical knowledge which must be taken into consideration, for much engineering wisdom and mechanical skill are employed in industry.

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Patents of a secondary nature, which this one surely is, must at most be strictly construed and each inventor is entitled only to the specific form of the alleged invention or improvement which he produces, **if it rises to the dignity of invention at all.**

Prior public use, sale, or **offer for sale** of an invention more than two years before applying for a patent therefor is fatal to any patent which may be issued therefor after that period. The statute is absolute and binding. As has been said: “A moment later and the inchoate right is lost beyond recall.” (Macomber: “The Fixed Law of Patents,” p. 63.)

Acquiescence in the rejection of original claims on prior patents, and the acceptance of amended and more restricted claims, binds the applicant to the imposed restrictions and limitations, and he is estopped from claiming a construction of his claims to give them a breadth equal to claims rejected.

In the language of Mr. Justice Brown:

“The object of the patent law in requiring the patentee to ‘particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery,’ is not only to secure to him all to which he is entitled, but to **apprise the public** of what is still open to them. The claim is the measure of his right to relief, and while the specification may be referred to to limit the claim, it can never be made available to expand it.”

*McClain v. Ortmayer*, 141 U. S. 419; 35 L. Ed. 800.

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### The First Inventive Act in Metal Spraying.

Probably the first inventive act in the art of spraying molten metal on to a surface was disclosed in the Morf U. S. patent No. 1,128,175, Defendants' Exhibit J, issued February 9, 1915, in which the idea of reducing metal to molten or liquid form and spraying it onto a surface was disclosed to the public, and in this patent the idea of moving a rod of metal into intersection with burning gases, under pressure for this purpose, is diagrammatically shown and explained.

The old French patent, Exhibit C, before referred to, issued in January of 1930, shows a very important mechanical embodiment of the invention disclosed in this

Morf patent, including the box type of metal spray gun. Defendants' gun is the closed box type.

The old French gun, Defendants' Exhibit N, which was taken in as a trade-in, furnishes an actual physical embodiment of the invention referred to.

Other prior patents are hereinafter referred to as showing the mechanical developments and embodiments of the invention first suggested by the Morf patent. Certainly much of the possible field for invention in this art was taken up by this French patent and these other prior patents, not considered by the Patent Office in issuing plaintiffs' patent in suit.

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### The Application for the Patent in Suit.

#### The Specification:

In the specification of the patent page 1, lines 5 to 10, second column, we have reference to the special form of the casting in these words:

"Another object of this invention is to provide in a metal spray gun a casting as an integral part which will contain the housings for encompassing the gears of the transmission as well as the turbine for driving the transmission gears and to so form the casting that it will have a channel way for the wire feed free and clear of the interiors of the gear and turbine housings."

And on page 1 of the specification, second column, lines 17 and 18, it is emphasized that

"By our improved structure the operator has a full vision of the wire, from the time of its en-

trance through the rear wire guide 47 and across the face of the knurled portion 34b of the lower wire feeding wheel into the front wire guide 48 . . . ."

#### Original Claims Rejected:

From an examination of the File Wrapper, Exhibit A, in the Lensch and Leder patent [R. 407], it is revealed that original claim 6 is the only one allowed out of the six claims asked for, and this was considered allowable only because it included "a baffle" in the nozzle base with "a plurality of openings therethrough adapted to direct the flow of compressed air from said nozzle base." This is claim 1 in the patent. Defendants do not use any such baffle. We point out, however, that French patent 741-740, Defendants' Exhibit B [R. 429], Fig. 4, clearly, and according to Mr. Stokes' testimony [R. 352], shows baffle plates in the nozzle to be old. This patent was not before the Patent Examiner in considering the application. Had it been, we doubt if said claim 6 would have been allowed.

The only patents considered by the Patent Office, according to the File Wrapper, were U. S. patent to Irons, No. 1,917,523, Exhibit H, and British patent No. 268,431, Defendants' Exhibit F.

Defendants' Exhibits B, C, D, E, G, I, J, K and L, are all prior art found by defendants and not found or considered by the Examiner.

In the first Patent Office action, the Examiner rejects claims 1 and 4 on the Irons patent, Exhibit H, "as obviously fully met."

The Examiner says:

“Claims 2 and 3 are each rejected as not presenting invention over the British patent, Exhibit F. In the British patent the wire feed wheels are located in a housing separate from the gear housing. The walls of the feed wheel housing of the British patent form a channel equivalent to that of applicants.”

“Claim 5 is rejected as drawn to an old combination. Irons shows the combination of a spray gun and a turbine. The specific form of the turbine and impeller does not have any cooperative effect on the combination. Applicant should claim the turbine structure *per se*. Claim 6 is allowable, as at present advised.”

#### New Limited Claims Presented:

By amendment filed, the attorney cancelled claims 1, 2, 3, 4 and 5, thereby acquiescing in the rejection of said original claims on the two prior patents cited; and three new claims were submitted, being present claims 2, 3 and 4 of the patent, and constituting the claims relied on in the charge of infringement against defendants. They all include the limitation inserted in order to secure allowance, which limitation defendants' device does not have, namely, an “open channel” construction which is shown to be of special form, made possible by a skeleton-like body casting.

“If a patentee acquiesces in the rejection of his claim on references cited by the Patent Office, and accepts a patent on an amended claim, he is thereby estopped from maintaining that the amended claim

covers the combination shown in the references, and from claiming that it has the breadth of the claim that was rejected."

*National Hollow Brake-Beam Co. v. Interchangeable Brake-Beam Co.*, 106 Fed. Rep. 693-714; 45 C. C. A. 544.

By examination of said original claims, we find that the clause involved, before amendment, reads as follows:

Claim 2. ". . . said member having a passageway exteriorly of the gear housings thereof and the walls of said passageway providing a channel," and later "said channel" is referred to.

Claim 3, designates it as "a channel way in said member free and clear of the interior of its gear chambers, . . ."

In other words, in all of the claims rejected, the space between the turbine and the gear housings on this casting is referred to as a passageway providing a channel for the wire feeding wheels. The casting with the turbine housing on one side, and the gear housing on the other side, is a skeleton-like form, leaving this necessary passageway or channel all open so that it can be seen from above and from the sides and the rear, for inspection of the wire and the wire feeding wheels during operation.

In all machines, including the box type, such as the old French patent referred to, and the "Mogul" machine, there must necessarily be a passageway or channel for wire feeding wheels, but they are inside the box structure, and the feed wheels therein cannot be seen without opening the lid or top of the box when the machine is not in operation.

### The New Claims and Their Limitations:

We now turn to the three claims which were prepared and substituted for the cancelled five claims.

Counsel most respectfully urges that the circumstances under which the new claims were prepared, the specific amendments included therein, and the argument used by the attorney who prosecuted the application, in order to persuade the Examiner to allow these claims, **are absolutely controlling**. Instead of mentioning simply “a channel” or “a channel way,” the term “open channel” was substituted for “channel,” and the meaning of, and the reason for, the “open channel,” were explained and urged as for “visibility” of the **feeding action while operating**.”

There would be no particular reason for providing an “open channel” for a machine **not in use**, for in all of the machines, old and new, the cover can be opened for inspection purposes, but **inspection is one thing, observation in action, or during operation, is another**.

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Now the limiting structural features in the three claims sued on are as follows:

Claim 2 contains the following:

“said member including housings for said turbine and gears and **an open channel** in its walls exteriorly of said housings, said wheels being adapted for rotation in said channel, . . . and means including **an abutment** between the **nozzle base** and the walls of said member for releasably confining said units in operative association **whereby said wire feeding wheels are visibly disposed** in said channel.”

The abutment referred to is at one side only and the nozzle base is attached thereto by three screws 63, which construction makes it possible to cut away the opposite side and leave the space open for the pipes, as seen in Figs. 1, 2 and 3 of the drawings.

Claim 3 contains the following limitation:

“and having **an open channel** in its walls between said housings, one of said wire feeding wheels being mounted on a shaft extending from the transmission gears beyond the housing thereof and adapted to rotate in **said channel**, the other of said wire feeding wheels being pivotally mounted on said member and adapted for rotation in **said channel** . . .”

Claim 4 contains the following definite limitation:

“means for effecting the visible feed of wire through said wheels comprising: an open channel in the walls of said member **between** the turbine and gear housings thereof, . . .” etc.

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By inspecting plaintiffs' gun [Exhibit 5], made under the patent in suit, it will be more clearly seen just what is meant by the expression “open channel,” and the statement: “whereby said wire feeding wheels are **visibly** disposed in said channel.” Or, “means for effecting the **visible** feed of wire through said wheels comprising: an open channel . . .” etc. As viewed from the rear, the top, or the sides, it will be seen that the structure is of open, skeleton-like form, and that the pipes to the nozzle, up through the handle, are also

positioned in this open area or channel and have plenty of room. Fig. 1.

The argument used by the attorney to persuade the Examiner to allow the amended claims is so important, we quote it as follows [R. 409-410]:

“Relative to Irons, No. 1,917,523: It is desired to note that Irons does not provide for the visible feed of the wire through the gun. He does not contemplate a wire feeding mechanism other than the ‘conventional’ construction which includes the wire feeding mechanism and feed wheels in the same housing without the ability to see the wire except by shutting off the tool and opening the cover of the mechanism housing, such, for example, as the Schoop type of wire feeding mechanism as contained in a square box housing. While Irons does provide separate power and combustion units, joining them together for operation, his structure does not teach applicant that with the conventional square box gear and feed wheel housing a channel can be formed exteriorly of the walls of the mechanism housing by the abutment of the nozzle base and the gear housing for the reception of the wire feeding wheels and so that the feed wheels will be open to view and the wire passing therethrough can be observed in its feeding. This utility in a metal spray gun is of great importance to a gun operator, particularly when inequalities in the metal sprayed deposits, due to irregularity of wire feed, require wire adjustments to be made while the gun is operating. Furthermore, the balling up of the wire, particularly with the softer metals such as lead, tin and zinc, requires expensive shutdowns and results in low output of the tool.”

Then referring to the British patent cited, the attorney says:

“Relative to British 268,431: What is said of Irons relative to **visible wire feeding** is equally true of the British structure, even though the wire feeding wheels are situated in a separate housing from the turbine and gear mechanism, because it is still necessary in this device to lift the cover of the wire feed wheel housing on the hinge 13 in order to see what is going on with the wire feed; in fact, the structure does not provide **visible wire feed**, even though it is one step advanced from Irons or Schoop in preventing contamination of the gears and bearings of the feeding mechanism from the particles or fines of the wire.”

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The attorney then calls the Examiner’s attention to an earlier Lensch and Leder patent No. 1,987,016 [Exhibit K] not cited, and says:

“It is desired to make this patent of record in this issue, as it has a direct bearing upon the removal of the wire feeding wheels of a metal spray gun from the gear box and mechanism contained therein, **whereby visible feed of the wire is occasioned** and the destruction of the gears and parts of the feeding mechanism from particles of the wire cut off by the knurled feed wheels is done away with . . .”

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Then he says:

“The new claims herewith presented are thought to fully differentiate applicants’ structure over the reference cited as well as over **their original structure**, and favorable consideration and allowance of same is courteously asked.”

We call attention to the structural feature which makes possible the very thing which the attorney referred to when he says in his argument:

“While **Irons** does provide separate power and combustion units, joining them together for operation, his structure does not teach applicant that with the conventional square box gear and feed wheel housing a channel can be formed exteriorly of the walls of the mechanism housing by the abutment of the nozzle base and the gear housing for the reception of the wire feeding wheels and so that the feed wheels will be open to view and the wire passing therethrough can be observed in its feeding.”

It is that structural arrangement in plaintiffs’ gun wherein the nozzle base is secured at one side only of the body casting with the three screws 63, to the abutment on one side, leaving the other side open, as hereinbefore referred to, and so clearly shown in Figs. 1, 2 and 3 of the patent drawings. Of course Irons does not teach this, nor does any other patent, for it is the only structural difference plaintiffs have over the French patent and the French gun.

“The case is one where, in view of the state of the art, the invention must be restricted to the form shown and described by the patentee. He was not a pioneer. He merely devised a new form to accomplish these results.”

*Duff v. Sterling*, 107 U. S. 636; 27 L. Ed. 517;  
*Newton v. Furst*, 119 U. S. 373; 30 L. Ed. 442;  
7 S. Ct. 369.

Counsel Would Bring in New Functions for  
"Open Channel."

Plaintiffs' counsel would now urge that the "open channel" is for the purpose of ventilation and that "it communicates with the atmosphere," and also that it is for the purpose of permitting any "fines" and "particles" to drop out. In other words, counsel for plaintiffs would bring into the picture these features in an effort to urge some other reason for the "open channel" limitation than that urged and argued by the attorney to persuade the Examiner to allow the claims.

It is only necessary to pick up defendants' gun to see that it is of the closed box type in comparison with plaintiffs' open, cut-away form of body, and only when defendants' upper feed wheel is tilted back can the wire and the lower feed wheel be seen, and this must be done when the gun is not in operation. All of the old closed box types afforded this means of inspection. That is: By raising up the lid and tilting it back on its hinge, the wire and the lower feed wheel can be seen. The old French patent discloses all of these features, and is the same as defendants' gun in all of the parts, separate housings, etc., with the upper feed wheel pivotally or hingedly connected to the body. The only difference in the French patent and defendants' gun is the fact that defendants, instead of using a cover, use a pivoted member which fits over the channel portion only of the body, but which substantially closes it against any observation while in operation. In said French patent, inasmuch as the turbine has a different housing, and the transmission gears have a separate housing, everything is enclosed except the space between the two housings and there is no need for a cover over the

whole area of the box. Defendants' upper wheel, when in operative position, does not permit inspection or observation of the operation of the feeding action. In other words, there is no "means for **effecting the visible feed of wire through said wheels comprising: an open channel in the walls of said member between the turbine and gear housings thereof**," as called for in the claims.

With the argument of the attorney for applicants in mind, it is only necessary to compare the open, cut-away body of plaintiffs' gun with the heavy, compact and closed form of body of defendants' gun, to realize that one is designed to give "visibility" of the feed action, while operating, while the other has no such provision or possibility.

Mr. Boyden testified repeatedly that there was no advantage in such a construction [R. 122-3], and Mr. Undell, plaintiffs' own witness, testified of the Mogul gun that:

"It is more sure, and you know, when you are going to light the gun, you are more sure that it is going to light and operate correctly." [R. 136-7.]

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A very important feature is to be noted about plaintiffs' gun and that is: When the upper feed wheel of plaintiffs' gun is tilted back, **the visibility is not changed**, for the wire and feed wheels are just as visible from the top, the rear and the right hand side. It is all open so that the feed wheels are exposed from the rear, from the top and from the side, and yet the construction gives bearings for both ends of the shafts without using the old closed box type of body.

Mr. Boyden in his testimony on cross-examination [R. 118] stated, referring to Plaintiffs' Exhibit 5:

"It is open all the way back here, a complete view of everything. It is open all the way around here, with a complete view in the front here, and the body of the gun here, or rather, the open channel, so-called, is open on the top and the bottom and the rear and the side, completely open."

Mr. Boyden also testified, referring to the Mogul gun, on cross-examination that:

"You cannot see the wire as it enters between the feed wheels or as it emerges from the wheels as you would hold the machine in operation."

When holding the Mogul gun in the hand, only the outer end of the rear wire guide can be seen as it projects out of the body; that from the left hand side it is only possible to see the side of the upper feed wheel, and when the upper feed wheel is tilted back in **inoperative** position, it is only possible to look down upon the top of the lower feed wheel, down in the small chamber formed in the body. Said chaniber is just large enough to receive the lower feed wheel and its gear. Its lower end is closed by the handle secured thereto, with the exception of a small hole and this is not visible when the handle is secured in place.

Referring to the enlarged photostats of defendants' gun. Plaintiffs' Exhibit **No. 9**, this might be misleading for it shows defendants' gun enlarged to four or more times the size of the actual gun, with the **upper feed wheel and hinged member thrown back in inoperative position**, and also with the handle detached. Counsel

undertook to use this as an argument that defendants' gun had an open channel, that is: open to daylight and ventilation and for the possible dropping out of the gun any "fines," purposes not even mentioned or suggested in the specification of the application.

Every effort has been resorted to to avoid the specific structure put into plaintiffs' claims by amendment in order to get them allowed, even over the only two references found by the Examiner, and over their attorney's argument in connection with the prosecution of the application as to the importance of "visibility" in observing the operation, and even Mr. Leder testified it was "an advantage to any gun to be able to see the wire going through there."

#### Testimony of Expert Witness, Mr. Stokes.

When we come to the testimony of Mr. Charles L. Stokes, who was brought in as an expert to testify on behalf of plaintiffs, we are strongly reminded of the decision in *Ideal v. Crown*, 131 Fed. 244; 65 C. C. A. 436, wherein the court said:

"Unhappily we cannot accept without reservation the opinions of the experts who have been examined as witnesses, for they are necessarily partisans of the side calling them, and essentially advocates, and their opinions are contradictory, and tend to perplex, instead of elucidating, although they appear to be gentlemen of great ability and deserved eminence."

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Mr. Stokes' testimony on direct examination adds nothing to what is perfectly clear from the patents examined and the specifications and drawings thereof to anyone un-

derstanding anything about mechanics at all, except to disclose how the witness always emphasized certain features **outside of the patent** which plaintiffs are urging in a strained effort to establish infringement, and most of which were brought into the case by plaintiffs' counsel in his opening statement.

We would therefore, call attention to the fact that there is absolutely no mention whatsoever of any "backfire" or of "explosion," or anything of the kind, in the specification or claims of the patent. There is no reference to any structure or features of the invention to take care of possible backfire or explosion.

Counsel also undertook to create the impression that plaintiffs were the first to provide what he called "two essential elements" namely: "a power unit or a wire feeding mechanism"; and the other he designated as "a combustion unit." These features have been shown to be old in the French patent, 680,554 [Exhibit C] and they all have them separated, as in the Lensch and Leder first patent; the metallizer gun, and the British patents.

**The only purpose** for the skeleton-like construction of plaintiffs' gun is to make possible the "open channel" to give "visibility" during operation for observation purposes [R. 410].

The only reason for referring to these features here is to show how Mr. Stokes becomes an "advocate" of these features brought into the picture by counsel in his opening statement.

For example, Mr. Stokes says [R. 342-3]:

“The open channel in the plaintiffs’ gun and in the defendants’ gun permits the passage of any ‘fines’ and that eliminates any wear from ‘fines’ on the wire feeding wheels.”

This is of no consequence and is not even mentioned in the specification, and it is not at all true of defendants’ gun, while it is true of plaintiffs’ gun.

It is only necessary to examine the testimony of “Expert” Stokes on cross-examination, as found on pages 328-355 to see how he was reluctant in many cases to give straight forward testimony as to matters which could be answered yes or no and as to facts which were self evident as physical structures. This is particularly true of his testimony relative to the French patent and the physical embodiment thereof, Exhibits C and N, as found at pages 344 to 355. And on the matter of the channel in the French patent he says: “It is a space. Let us put it that way.” [R. 353.]

It is clearly evident from the evidence that the prior art discloses every structural feature which is set forth in the claims of the patent sued on; that what was done, even over the two patents cited by the office, was only ordinary mechanical skill; that when we take into consideration the other patents referred to, and especially the French patent [Exhibit C]; and the French gun [Exhibit N] and the Spanish circular [Exhibit O] “El Salvador” and the illustrations thereon, that the cover of this French patent, clearly shows an oval opening of considerable size for the spring latch, and that the chamber, or channel, or space, in this French gun body would have to be considered as

much an "open channel" as that shown in the Mogul gun. But "open channel" in the patent sued on is a different thing. Plaintiffs' gun is designed with an open and cut-away frame or body casting to provide the visibility, and even uses only one side of the body for attaching the nozzle base. This is the difference between the plaintiffs' gun and the Mogul gun. The "open channel" is formed between the housings in the body and the walls thereof, and in that true and actual sense, plaintiffs' gun is the only gun in all the prior art so constructed and arranged.

To construe the term "open channel" as readable on the Mogul gun, is to give it a construction which would render the claims invalid on the French gun, for its chamber is open for ventilation purposes in the unusually large latch opening.

#### **Defense of Prior Public Use and Offer for Sale.**

One of the defenses urged by defendants was that the invention of the patent in suit was made and offered for sale more than two years before the filing of the application for the patent. This defense was urged under a full general denial in paragraph IV of the Answer. [R. 11, 12.]

Plaintiffs contended that it was a special defense and that further particulars were required. The Trial Court permitted an amendment to the Answer. [R. 17a, 150.]

Defendants urged that "Under the New Rules" it was sufficient to deny the allegations of the complaint that the improvements were "not in public use or on sale in this country more than two years prior to said application." but took advantage of the Court's offer to "allow an

amendment to specifically plead" the defense to be offered, as was done. [R. 150.] The amendment was as follows:

"XVII. For a fourth, further and separate answer and defense, said defendants allege that the invention of the patent sued on herein was known and used and circularized and offered for sale for more than two years prior to the filing date of the application on which said patent was issued, which filing date was April 13th, 1936; namely, as early as April 5th, 1934, and prior thereto, when the Metal Spray Company, by its manager, H. B. Rice, issued a circular letter 'To ALL DISTRIBUTORS AND AGENTS,' calling attention to the 'NEW TYPE GUN' and to the special Bulletin 500; that one of said letters was signed by and sent by said H. B. Rice, as manager of said company, to and was received by Wm. M. Britton, a dealer; and that said original letter and one of said bulletins 500 are ready and will be offered in evidence to prove such public use and sale."

The special letter "To All Distributors and Agents," Defendants' Exhibit M, appears at pages 257-265, and the Bulletin 500, is reproduced at pages 266-269 of the record. The testimony of Harry B. Rice, the man who wrote the letter and signed it, and added at the bottom a handwritten note to Mr. Britton [R. 265], identifies the letter and the date "April 5th, 1934"; and the testimony of Mr. William M. Britton identifies the letter as the one he received, and the handwritten note thereon is the "distinguishing mark." [R. 300.]

The testimony of Mr. Rice [R. 271-3] definitely establishes that he as salesman, took the new gun to San Francisco and displayed it to one George Stoddard on the Friday preceding February 19, 1934.

The testimony following [R. 274-275] discloses the fact that the machine was actually used in March, 1934. Mr. Rice further testifies that "During discussion in the summer and fall of 1935, I expressed myself as of the opinion that the application could safely be filed in December of 1935 or January of 1936. I was very much in doubt concerning the matter after that time."

It was certainly "on sale" when the letter was sent, accompanied with a bulletin showing the gun with full and detailed explanations, and was displayed to Mr. Stoddard "in order to aid in convincing him that he should cancel his distributing agency at that time so I could give the distribution to other parties." [R. 272.]

Mr. Britton testified, relative to the circular, "I received a number of circulars of this type from Mr. Rice" [R. 300-302]; that "it was customary for him to receive letters from Mr. Rice"; "It (such a letter) was received in the spring of 1934, as I remember." In answer to the question: "Did you ever receive and sell any of the guns referred to?" Mr. Britton answers: "I received one of the guns; yes, sir." "That was in the spring of 1934." [R. 302.] "It was turned over to the agency in Detroit who succeeded me." "And that was in the spring of 1934."

This issue was decided against defendants, wrongfully we thought, and therefore it is brought to this Court without cross-appeal under the decision in **Oliver-Sherwood Co. et al. v. Patterson-Ballagh Corporation et al.**, 95 Fed. (2d) 70, this circuit, which held:

"Where patents are held valid but not infringed and plaintiffs appeal and attack the finding of

noninfringement, defendant, without a cross-appeal, may attack that portion of the findings and decree which holds the patent valid."

See also:

*Herman Body Co. v. St. Louis Body Co.*, 8th Circuit, 46 Fed. (2d) 879.

#### Summary of Evidence Supporting Prior Public Use and Sale:

Referring further to the testimony of Mr. Rice, he definitely testified as follows:

That he was familiar with mechanisms of the character involved in this suit and that he held managerial positions for companies; that he was associated with the Metallizing Company of Los Angeles as early as 1930 or 1931, a shop which did job spraying [R. 222]; and was superintendent of the shop; that he had frequently operated spray guns; that after leaving the Metallizing Company in the spring of 1931, he became associated with Mr. Lensch and Mr. Leder [R. 226-7] in an exceptional arrangement; The Metal Spray Company was registered in the county with himself as the sole owner; Mr. Lensch had the shop and shop equipment; and Mr. Leder was working and supplied the labor in connection with metallizing and spraying; Mr. Rice did the field work, developed applications, obtained jobs and business, etc., at that time they were using a gun of a box type, similar to **all box types of guns**, such as the Schoop and the early **Metallizing gun**; that the gun which we were using at that time was a gun on which Lensch and Leder had a patent, No. 1,776,332, issued September 23, 1930 [R.

231] Defendants' Exhibit L; that the gun covered by Lensch and Leder patent No. 1,987,016, of January, 1935, Defendants' Exhibit K, was developed in August or September, 1931, or within six months of the time Rice entered into the arrangement with Lensch and Leder [R. 229], and the first guns were sold shortly before Thanksgiving of 1931; that one objection to this gun, Exhibit K, after it had been in the field for six months or a year, was the fact "that the outside wire feeding wheels were supported only on one side of the case." [R. 233.] He says: "I thought it would be an excellent idea to incorporate a bearing on the outside, or rather on both sides of the wire feeding wheels." And the second objection was the fact that in the Model 125 gun [Exhibit K] the tension spring used to exert pressure on the upper wire feeding wheel, in order to hold the wire in feeding position, was a fixed spring tension and not subject to manual variation. [R. 233-4.]

Mr. Rice further testified [R. 234] that Lensch and Leder made the changes and brought out the Model 126, which is the plaintiffs' gun, Exhibit 5, "incorporating an outside bearing on the feeding wheels, keeping the rear of the nozzle separate from the gear chamber and, in addition, effecting a much better balanced gun." He says that this gun was developed in December of 1933, or January of 1934. [R. 235.] "By this I mean the first model of the gun." [Exhibit 5.]

He refers to the "customary practice" of testing in the shop, to get the necessary information "for me to write a manual of instructions which had to accompany the gun." [R. 235.] He stated that these tests went on for

probably 30 days; that the next stage was the photographing of a finished model in order to produce cuts or electro-types in order to print the circular and to disassemble the gun completely and lay out the parts in such manner that they could be numbered and photographed in order to use in connection with the manual of instructions. [R. 236.]

Mr. Rice further testified that "the gun that was photographed or the gun that was produced ready for photographs must have been in my hands, I would say, the early part of **March** or the middle or last of February," 1934. [R. 236.]

Mr. Rice identified a carbon copy of a letter addressed: "Los Angeles, California, April 5, 1934; Subject, New Type Gun; to all distributors and agents." [R. 237] as a letter written and signed by him and sent to a Mr. Britton, with a personal note at the foot thereof, written in Mr. Rice's own hand to Mr. Britton. This letter is Defendants' Exhibit M. [R. 239.]

This letter referred to a Bulletin 500 which accompanied it and this Bulletin showed a cut of the completed gun thus ready and offered for sale at that time. [R. 240-241.]

Mr. Rice also testified relative to one of their dealers in San Francisco in 1934, DeLaval Pacific Company, with whom he corresponded, and identified a letter of March 17, 1934, which he wrote. [R. 254-255.] Letter and Bulletin, Exhibit M. [R. 257-269.]

He testified that the spray gun, made under the patent in suit, was completed and ready for demonstration "In December, 1933, or January, 1934;" [R. 271.] That he took it to San Francisco and displayed it to their agent—The DeLaval Pacific Company; to Mr. George Stoddard on Friday preceding February 19, 1934. [R. 271-273.]

Mr. Rice further testified [R. 272] that "The gun was displayed to Mr. Stoddard in order to aid in convincing him that he should cancel his distributing agency at that time so I could give the distribution to other parties, showing—or I should particularize. The question of the cancellation involved my taking back four old style guns at their cost. And the purpose of displaying the gun was to convince the distributor that they might not be able to sell the four old-style guns prior to a general announcement of the new gun." The agency was established at that time, and "that was in February, 1934." [R. 273.]

About the gun, he testified "I know it had not been patented." "I was informed by Lensch and Leder that their patent attorney at that time had not considered the features of sufficient uniqueness to obtain a patent; that only mechanical skill and ingenuity was involved;" the matter was discussed between Mr. Rice and Mr. Martin. [R. 273.] Mr. Rice says: "I expressed myself as of the opinion that the application could safely be filed in December of 1935, or January of 1936. I was very much in doubt concerning the matter after that time." [R. 275.] This testimony was not contradicted by Mr. Martin.

Mr. Rice testified that the gun was used in the shop as follows: "It was used in the custom shop for tests, for job work on a number of occasions in March, 1934." [R. 275.] It was used after that "on regular job work" and gave satisfaction.

On cross-examination, Mr. Rice confirmed his testimony that the Bulletin 500 was copyrighted in his own name and explained why. [R. 278.] He had previously testified [R. 242-3] that "In 1935, September 17th, to be exact the Metal Spray Company, unincorporated, the previous company, was taken over by the Metal Spray Company, Inc., a corporation, formed by Mr. Martin and myself. This purports to be, this circular which I produced here from my portfolio, is a reprint, a copy of the original circular, with the name Metal Spray Company, Inc., attached thereto." "That is the only difference."

This testimony explains the slight difference in the two Bulletins 500 presented. The one sent with and referred to in the letter of April 5, 1934, was of the first batch and did not have the company name printed on it.

On this bulletin, sent with the letter of April 5, 1934, was a photograph or cut of the spray gun which had been completed, tested, used in the shop and was being offered in this way for sale as early as April 5, 1934, and was exhibited to Mr. Stoddard in San Francisco as early as February 19, 1934 by Mr. Rice himself. [R. 251.]

### Mr. Britton Confirms.

Mr. William M. Britton in his testimony, said he had been in the metal spray business since 1933; that prior to that he was in engineering work; that he was a major in the United States army in the last war; that he had an agency for a metal spray gun in Detroit, in 1933 [R. 298]; that he was the Metal Spray Company of Los Angeles; that Mr. H. B. Rice was the sales manager at that time and that he had correspondence with Mr. Rice.

Mr. Britton also testified, after some refreshing his mind and examining the letter (Exhibit M), that he received the letter from Mr. Rice. He says, after examining the letter: "Yes. It says—or that is a distinguishing mark." [R. 300.] It says, "Mr. Britton: Under another cover, by airmail, am sending essential pages of the manual. The complete manual is going forward by regular mail. **'That does identify it as the circular letter which I received.'**" He also testified that he received the circular Bulletin 500, or "I received a similar circular from the Metal Spray Company." "I gave him (Mr. Boyden) a circular along with the letter, yes, sir." [R. 300.] So that Mr. Britton's testimony established the receipt of the letter of April 5, 1934, Exhibit M, and one of the Bulletins 500, and confirms the testimony of Mr. Rice about the letter and the Bulletin 500, with cut of the gun thereon.

Mr. Hicks Printer of Manual.

Mr. Hicks testified [R. 308] that he is in the "Printing and letter service"; has been in that business about seventeen years; that in April, 1934, he did printing for the Metal Spray Company; that he "mimeographed some manuals, manual of instructions"; he presented one of the manuals and described it, and that down in the lower left-hand corner it says: "Copyright 1934, H. B. Rice." That the particular copy came from his own files; that it was completed and delivered on April 7th, 1934; that the bill or price was \$29.25; that he received a check for the amount and identified the check, and said: "Yes, it is, and I recognize it also from the fact that the name, 'The Hicks Company', is written in my own writing. I wrote that myself." [R. 309.]

The manual was introduced in evidence and marked "Defendants' Exhibit P [R. 310], and it was stated that this manual was the manual of instructions set out to dealers and was the manual referred to at the bottom of the letter of **April 5, 1934**, written by Rice to Britton, and contained full instructions about the new style gun. Mr. Hicks also referred to duplicate invoice from his files and further identified and confirmed his testimony about the printing of the manual as testified to. The check given to Mr. Hicks was also introduced and marked "Defendants' Exhibit Q." [R. 312.]

Mr. Brown Called by Plaintiff.

Mr. Brown, of the New Method Printing Company, called as a witness by plaintiffs [R. 313], was uncertain in his testimony only as to the first run of Bulletin 500 which he printed; the record which he had was simply a cash entry sheet showing cash received with no identification [R. 314-5], but showing that he received a payment by check dated June 28, 1934 in the amount of \$30.00; Mr. Brown says, on cross-examination: "I am under the impression that the first time we did business with him that he paid cash for the order right promptly afterwards. The longer we did business the slower the payments came." [R. 318.]

Mr. Leder Recalled.

Referring to the matter of the completion of the gun in question, Mr. Leder testified [R. 319]: that their gun was completed as early as February, 1934; that they started somewhere about October of 1933. [R. 319.] This corresponds with the testimony of Mr. Rice who testified [R. 235]: "This gun was developed, based upon my memory, which has been checked recently by some correspondence I have, and as I would estimate, in December of 1933, or January of 1934." "By that I mean the first model of the gun." He also testified "that these tests went on for probably 30 days."

Mr. Leder further testified that he had no knowledge of this gun being taken out of the shop by Mr. Rice and shown to anyone in San Francisco in February of

1934, on cross-examination, but he admitted that Mr. Rice was salesman, and talked himself into being sales manager [R. 323]; that his business was to sell guns; that "After we had the gun going and so on, and as he was the salesman, he could more or less indicate what the trade wanted, in an endeavor to make it applicable to certain features which were to our advantage for sales." "And it was his business to explain this gun to prospective customers and to explain its merits." "Mr. Rice would naturally, have to have the gun in order to exhibit it to different customers, prospective customers." [R. 325.] "After it was ready and finished and so on, we consented to let him take it out to customers or prospective customers for demonstration" and "permitted him to take it out and have it photographed in order to prepare the circulars for advertising." "And these circulars were made from this particular gun, the first gun that was made." [R. 325.] Mr. Leder avoids saying whether they had any other guns in the process of manufacture about the same time. He also testified as to the advantages of making their gun cut away in front so as to expose the feed wheels and the passing of the wire into the nozzle, and also in the rear, and when asked if there was any advantage to be able to use your gun and to see the wire passing through there, he answered: "Well, it would be an advantage to any gun to be able **to see the wire going through there.**" [R. 327.] To see the action or operation, of course, is the only purpose of so constructing the body as to provide openness, referred to

as an open channel. He does not say anything about inspection when not in operation. When asked the question: "**And is it an advantage to have that structure a skeleton, showing it left open?**" he answered [R. 327]:

"Not only that. It is also an advantage in reducing the weight of the tool, because the heavier the gun will be in the hand of an operator the quicker the operator will get tired and have to rest, but taking out every little bit of weight in the gun, it enables the operator to keep on operating a longer period of time." "So that in addition to giving visibility from front and rear of the feed wheels you have a lighter machine." [R. 327.]

In this connection we would again call attention to the special construction of the plaintiffs' gun to be seen in Figs. 1, 2 and 3 of the patent drawings, which shows how the nozzle base 49 is secured in place by one side only by three screws 63, leaving the other side wholly open and free and clear of the gear and turbine housings. There is no such construction and arrangement found in the prior art and if there is any invention in the gun at all, over the spray gun art, it must be limited and confined to this specific arrangement for forming the "open channel" for visibility of the mechanism mounted therein, namely: the feed wheels, the wire guides and the wire as it is moving therethrough.

Defendants do not have such a construction, but on the contrary, have a heavy, mogul, type of body, more like a closed box with everything housed therein and with no visibility whatsoever of the operating parts while the gun is in operation. To try to see into it while it is operating would certainly be ridiculous.

“The Metallizer”, Defendants’ Magazine . . .

Plaintiffs have seen fit to introduce into the record, in order to show defendants’ activity in advertising and pushing their guns, the Official Organ of the International Metallizing Association, of certain dates, as follows, to-wit:

“Midwinter Number December, 1935-January, 1936.”  
Ex. 10-a [R. 75];

“February-March, 1936.” issue. Ex. 10-b [R. 78];

“April-May Issue, 1938.” Ex. 10-c [R. 82];

“June-July Issue, 1938.” Ex. 10-d [R. 86];

These publications clearly establish the fact that the “MOGUL” gun was already on the market prior to the “February-March, 1936” issue of “The Metallizer,” and this was long prior to the date of the patent sued on, namely, October 19, 1937.

Witness Boyden, the designer thereof, testified [R. 159] that the “MOGUL” gun was brought out in 1936.

From the “Midwinter Number December, 1935-January, 1936” issue, above referred to, we have the following:

“The Metallizing Company of America will soon have available in addition to their ‘Metallizer’ gun a new metal spray unit known as the ‘MOGUL’. This piece of equipment has been designed and built with but one thought in mind: *i. e.*, to offer to the public the finest piece of metal spraying equipment it is possible to produce to-day.” [R. 75-76.]

“Possessing the same general characteristics as the well-known ‘Metallizer’, certain features have been incorporated which make the ‘MOGUL’ particularly adaptable to certain classes of severe service and there is little doubt that it will find a welcome in this respect.”

But, quoting from the issue of “February-March, 1936” Exhibit 10-b [R. 78-79], we have:

“Photo shows ‘MOGUL’ Unit mounted on Lathe, spraying Stainless Steel on pump rod. Actual time check showed 10.2 lbs. sprayed in one hour. Smooth coating obtained.” \* \* \* (Photo omitted.)

Then follows:

“Since the event of the Mogul Metallizing Gun, the public has shown such inquisitive interest that the writer decided to go over and pay a visit to the inventor of the tool which is causing such active comment. Mr. Charles Boyden of the Metallizing Co. of America Inc. is the gentleman responsible for this tremendous advancement in the metal spraying field.” [R. 78-79.]

#### **The Law—Mechanical Skill v. Invention.**

“A device which displays only the expected skill of the maker’s calling, and involves only the exercise of ordinary faculties of reasoning upon materials supplied by special knowledge, and facility of manipulation resulting from habitual, intelligent practice, is in no sense a creative work of the inventive faculty, such as the Constitution and patent laws aim

to encourage and reward." *Williams Mfg. Co. v. Franklin*, 41 Fed. Rep. 393, 395.

*Hollister v. Mfg. Co.*, 113 U. S. 59, 28 L. Ed. 301;

*Thompson v. Boisselier*, 114 U. S. 1; 29 L. Ed. 76;

*Atlantic Works v. Brady*, 107 U. S. 200; 27 L. Ed. 438.

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"Long practice and observation naturally lead those familiar with the arts to the perception of new adaptations. Mechanical education and skill, fostered and promoted by the public, are rapidly advancing in every direction, and there is a constant and universal endeavor in handicraft to utilize that which is known, and press it into service in the practical arts. But the steps of this normal progress and improvement are not invention, nor the subject of monopoly to one who, in the exercise of the 'skill of his calling,' has put an old thing to a new use."

*Capital Sheet-Metal Co. v. Kinnear & Gager Co.*, 87 Fed. 333, 336; 31 C. C. A. 3.

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In contrasting invention and mechanical skill Judge Nixon, in *New York Belting & Packing Co. v. Magowan*, 27 Fed. Rep. 362, 364, said:

"Invention indicates genius and the production of a new idea. Mechanicall skill is applied to an old idea and suggests how it may be modified and made more practical."

In the case before us, the invention was performed by Morf and by patentee in the French patent, and by Irons and by Valentine, if there was any room for invention following the French disclosure.

Defendants' contention is that after all of the mechanical features disclosed in the French patent, following the generic invention by Morf, had been made known to the world, only ordinary mechanical skill was required to produce any of the patents thereafter, and then, after all of the disclosures made in the art presented by Defendants' Exhibits B, D, E, G, H, I, J and K, to attribute invention to plaintiffs' mechanical refinements in their metal spray gun is to deprive the public and industry of mechanical and engineering and inventive knowledge which has already been dedicated to them.

Plaintiffs have done nothing more than **to carry forward old ideas** in an effort to make a more efficient metal spray gun and in doing this they have used only mechanical skill, just as Defendant Boyden did when he undertook to improve their Metallizer gun after gathering some new ideas from the French patent and other foreign patents.

*Smith v. Nichols*, 88 U. S. 112;

*Penna. v. Locomotive*, 110 U. S. 490;

*Stephenson v. Brooklyn*, 114 U. S. 149; 29 L. Ed. 58;

*Consolidated v. Walker*, 138 U. S. 124; 34 L. Ed. 920.

Merely to change the form of a machine is the work of a constructor, not an inventor. Such a change cannot be deemed an invention.

*Winans v. Dermead*, 15 How. 330; 14 L. Ed. 717.

Any change in form, though better, is not invention.

*Belding v. Challenge*, 152 U. S. 100; 38 L. Ed. 370;

*Atlantic v. Brady*, 107 U. S. 192;

*Hollister v. Benedict*, 113 U. S. 59;

*Thompson v. Boisselier*, 114 U. S. 2;

*Busel v. Stevens*, 137 U. S. 423;

*Duff v. Sterling*, 107 U. S. 636; 27 L. Ed. 517;

*Newton v. Furst*, 119 U. S. 373; 30 L. Ed. 442.

### Secondary Patents.

That Secondary patents are subject to very strict construction and interpretation is well settled in the law, and this is necessarily becoming more and more necessary and is even going over into invalidity, otherwise there is bound to be great abuse of the patent monopoly. It has well been said:

“But if the advance toward the thing desired is gradual, and proceeds step by step, so that no one can claim the complete whole, then each (inventor) is entitled only to the specific form of device which he produces, and every other inventor is entitled to his own specific form, so long as it differs from those of his competitors, and does not include theirs.”

*Chicago & N. W. Ry. Co. v. Sayles*, 97 U. S. 554-557; 24 L. Ed. 1053.

This was the policy and the law many years ago, but, as before herein emphasized, the advance and development in the field of Engineering knowledge and mechanical skill has been so wonderful, that very much of so-called invention must to-day be classified as mechanical skill in the interest of the public and industry.

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In *Consolidated v. Barnard*, 156 U. S. 261; 39 L. Ed. 417, it was held that the patent sued on was not a pioneer patent, and is not entitled to that liberality of construction which would have been accorded it had the inventor been the first to devise a scheme for these several adjustments.

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A primary invention is “one which performs a function never performed by an earlier invention.” A secondary invention is “one which performs a function previously performed, but in a substantially different way.” Walker on Patents (Fourth Ed.), Sec. 359. See:

*Western v. Robertson*, 142 Fed. 471, 478; 73 L. Ed. A. 587.

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### Self-Imposed Limitations in Claims.

In view of the law requiring an inventor not only to describe his invention in great detail and the manner and process of making, constructing, compounding and using it, but to “particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery,” the rule would seem to be self-evident. The claim is the measure of the rights of

the patentee and its limitations are the limitations of his rights. As stated by Judge Townsend, in *Matheson v. Campbell*, 69 Fed. 597, 607:

“No. principle has been more firmly established and consistently applied, in the Federal courts of last resort, than that the patent must be construed in conformity with the self-imposed limitations contained in the claims. The application of this principle of construction may be invoked in support of the validity of the patent as well as in denial of infringement.” Citing:

“*Groth v. Supply Co.*, 9 C. C. A. 507; 61 Fed. 284;

*McClain v. Ortmayer*, 141 U. S. 419; 35 L. Ed. 800.”

“If an applicant, in order to get his patent, accepts one with a narrower claim than that contained in his original application, he is bound by it.”

*Shepard v. Carrigan*, 116 U. S. 593.

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“Complainant is not at liberty now to insist upon a construction of his patent which will include what he was expressly required to abandon and disavow as a condition of the grant.”

*Morgan v. Albany*, 152 U. S. 425; 38 L. Ed. 500.

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In the case at bar, the application was rejected. The claims amended and restricted to an “open channel” construction and arrangement, and the attorney argued and emphasized that the “open channel” construction was for an important purpose: “visibility of operation.”

### Prior Public Use and Offer for Sale.

The period of two years provided in the Statute was a long and liberal time allowed an inventor to develop an invention. This period has just been recently cut in half, and only one year will be allowed after August, 1940, for an inventor to get his application filed after getting his invention ready for use, or for sale.

In the case of an offer to sell, the Court of Appeals in *Wende v. Horine*, 225 F. 501, 504 (7th Cir.), said:

“If Horine’s letter amounted to an offer to sell the apparatus, then clearly these letters, standing alone, put it ‘on sale’ within the meaning of the Statute to the only immediate prospective customer just as effectively as a distributed price list puts an article on sale to the public.” Cases cited.

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On the subject of whether an inventor is justified in delaying more than two years after he makes his invention before he files his application, the courts generally resolve all doubts against the inventor as it is the policy of the law to encourage the inventor to file his application and ultimately to make a prompt disclosure to the general public through his patent.

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In the case of *Woodbridge v. United States*, 263 U. S. 50, 56, the Supreme Court says:

“The importance of working out the purpose of Congress of keeping the inventor’s monopoly within the term for which the patent is granted, is thus shown to be capital. Any practice by the inventor and applicant for a patent through which he deliberately and without excuse postpones beyond the date

of the actual invention, the beginning of the term of his monopoly, and thus puts off the free public enjoyment of the useful invention, is an evasion of the Statute and defeats its benevolent aim."

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One must be very careful not to make any publication which is more than the statutory period because this will bar his getting a patent.

In *Wagner et al. v. Meccano Limited* (6th Cir.), 246 Fed. 603, at page 607, we find:

"The manual was a prior 'printed publication' within the meaning of section 4886, Rev. Stat. U. S. (Comp. St. 1916, Sec. 9430); and its effect upon the patent in suit is in principle the same as if the manual had been put out by a stranger. *James v. Campbell*, 104 U. S. 356, 382, 26 L. Ed. 786; *Schieble Toy Novelty Co. v. Clark*, 217 Fed. 760, 766, 133 C. C. A. 490 (C. C. A. 6)."

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Plaintiffs in this suit issued their printed manual (Bulletin 500) and their "Letter to All Distributors and Agents," with photographs of the finished machine, more than two years prior to the date of application.

The foregoing case deals with the question of Invention vs. Mechanical Skill, and holds that what was done did not amount to invention.

The application on which the Lensch and Leder patent was issued was filed April 13, 1936.

The evidence clearly shows that the invention had been developed, tested and used in job work in a job shop prior to April 5, 1934; prior to which the photographs were taken, the circulars and manuals were prepared and mailed, and as early as March 17, 1934, Rice wrote

to DeLaval Pacific Company in San Francisco about the gun [Ex. M.] [R. 254-5]; that in February, 1934, he took the gun to San Francisco and exhibited it to Mr. Stoddard; that the agency was established at that time, and "that was in February, 1934." [R. 271.] Mr. Britton confirmed Mr. Rice's testimony about the letter of April 5, 1934, and Bulletin 500, delivered therewith, and Mr. Leder could not but admit that Mr. Rice had to have the gun to exhibit it to "different customers, prospective customers." And he says: "After it was ready and finished and so on, we consented to let him take it out to customers or prospective customers for demonstration" and "permitted him to take it out and have it photographed in order to prepare the circulars for advertising." [R. 236.]

All of this was necessarily prior to April 5, 1934, for it took time to get the photographs, have the electroplates made, and the circulars printed.

Mr. Hicks, the printer, confirmed the delivery of the manuals on April 7th, 1934, and presented a complete copy from his files, marked "Copyright 1934, H. B. Rice." Some sheets of the manual were sent with the letter of April 5, 1934, as per the footnote written by Rice to Britton, and the complete manual was sent later regular mail.

There was thus an abundance of evidence to establish public use and disclosure and offer for sale within the holdings of the decisions on this question.

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In *National Biscuit v. Crown Baking Co.*, 105 F. (2d) 422, 425, it is held that substantial completion of the invention two years before is sufficient to start the statutory period under the "use" provision running.

In *Globe Oil Refining Co. v. Sinclair Refining Co.*, 103 F. (2d) 95, 97, it is said:

“We think that our conclusion is further supported by the fact that Bell delayed for nearly two years in filing his application. This would tend to indicate that at the time he developed his improvement he himself did not consider that it involved invention. See *Miller v. National Broadcasting Co.*, 3 Cir., 79 F. (2d) 657.”

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That prior public use is a bar to patent whether the use was with or without the consent of the patentee, see

*Electric Storage Battery Co. v. Shimadzu*, 307 U. S. 19.

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In *Maibohn v. R. C. A. Victor Co.* (4th Cir.), 89 F. (2d) 317 (321):

“A number of decisions are to the effect that the statute does not require a complete sale but that placing on sale is sufficient.”

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In *American Stainless Steel Co. v. Rustless Iron Corporation*, 71 F. (2d) 404, 407, it is held:

“The rule undoubtedly is that a prior use, in order to negative novelty in a patent, must be something more than an accidental or casual one. It need not have been persisted in, and the thing produced need not have gone into commercial use; but at least the discovery must have gotten beyond the experimental stage and have become complete, and the inventor must have understood and appreciated that it was capable of producing the results sought to be accomplished.” Cases cited.

## CONCLUSIONS.

We respectfully submit, therefore, that every one of the defenses which we have presented is good and valid, and is supported by the evidence and the law.

Defendants have developed and supplied to the public and to industry an improvement in metal spray guns which is different in more ways from plaintiffs' gun than it is from the French gun, after which it was designed, and have produced a gun which plaintiffs' own witness Udell described as "a much nicer gun to operate than the Metallizer" which was defendants' earlier gun, and he further said of the Mogul gun "you are more sure it is going to light and operate correctly." [R. 137.] It is a gun which has passed every test of the **Underwriters**, and when compared with the plaintiffs' gun, it is radically different in design and weight, and it does not provide, nor does it require, an "open channel" construction and arrangement in order to **observe** the wire and the feed wheels during the operation. Such a construction is of no advantage in defendants' gun.

On the defense of Mechanical Skill only being involved in the patent in suit, and not invention, we submit that the Court should find the claims invalid "as not presenting invention", as found by the Patent Office on the original claims based on **only two prior** patents—Irons and British; whereas the court has had many other prior patents, including the most pertinent French patent and the French gun, Defendants' Exhibits C and N. There can be no question, we submit, that in view of the development of the art and the disclosures not before the Patent Office, that this patent is invalid as not in-

volving invention. The public has rights which must be safeguarded.

On the defense that the patent is a SECONDARY patent, and is limited absolutely to the specific construction and arrangement of a body casting to which the nozzle is attached and supported at one side only, whereby to make possible an open space or channel for the wire feeding wheels and wire, we submit that the evidence is conclusive, and is supported by the specification and claims, and by the arguments used in order to secure the allowance of said restricted claims, and if it is found that there is invention involved, in view of all the prior art, then we submit that such invention is of the most secondary and limited nature, and said claims are not infringed by defendants' Mogul gun, which is of the closed box type, and is far more similar to the old French gun. Any broader construction of the claims would render them invalid on the prior art. The specific construction brought into all the claims alleged to be infringed is for the purpose of providing "means for effecting the visible feed of wire through said wheels comprising **an open channel** in the walls of said member."

On the defense of Prior Public Use and Offer for Sale, we submit that the evidence is sufficient and clear, under the decisions referred to and others with which this Court is no doubt familiar, to hold that said patent is invalid for this reason. The invention was in condition for use and for demonstration, and for photographs from which to prepare the advertising matter, and was fully disclosed and described in the Bulletin 500, and the manual printed to describe it, long before the applica-

tion for the patent was filed, namely: prior to February of 1934, whereas the application was not filed until April 13, 1936, several months more than two years allowed by the statute for filing an application after completion. This period of two years was considered most liberal and has now been cut to one year.

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We confidently believe that this Honorable Court, with larger experience and knowledge of patent matters and of the law on patents, and in view of the prior art which the Patent Office did not have before it, will hold that the patent is invalid for lack of invention, or because of prior use and actual offer for sale more than two years prior to filing the application.

If the Court does not see its way to go this far, then we believe that the decision of the Court below will be affirmed, which we most respectfully urge.

Appellees' cause is most respectfully submitted for the kindly consideration and decision of this Honorable Court.

Respectfully submitted,

WILLIAM R. LITZENBERG,

*Attorney for Defendants.*

Los Angeles, California, April 6th, 1942.

